

Application No.: 10/815,149
Amdt dated: September 11, 2008
Reply to Office action of June 12, 2008

Amendments to the Drawings:

Please enter the attached Replacement Sheet including Figure 6. In the Replacement Sheet, elements 61 and 63 referring to the bridge and extension have been renumbered 65 and 67 respectively. No new matter has been added with this amendment.

Attachment: Replacement Sheet

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REMARKS/ARGUMENTS

Claims 10-18 were considered by the Examiner. In this paper, Claims 10 and 12 have been amended, Claims 24-28 have been added, and Claims 1-9 and 19-23 have been canceled without prejudice. Accordingly, Claims 10-18 and 24-28 are now before the Examiner for consideration. No new matter has been added in this amendment.

Regarding the Objection to the Drawings

The drawings were objected to for failing to comply with 37 C.F.R. §1.84(p)(4) because reference character 61 had been used to designate both the "jaw" and "bridge" in Figure 6. In the section above entitled Amendments to the Drawings and its associated attachment, Applicant has provided a Replacement Sheet for Figure 6 in which the bridge has been labeled with reference character 65. Applicant has also revised the reference character for the "extension" to be reference character 67. In the section above entitled Amendments to the Specification, Applicant has directed replacement paragraphs to be entered in the Specification to correspond to these revisions. No new matter has been added with these amendments.

Summary of the Claim Rejections Presented in the Office Action

In the Office Action, Claim 12 was rejected under 35 U.S.C. §112 as being

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indefinite. Claims 10-18 were rejected under 35 U.S.C. § 102(a) as being anticipated by Yawata et al. (PCT Patent Application Publication No. WO 2004/008944). Claims 10-18 were rejected under 35 U.S.C. § 102(b) as being anticipated by Burbank et al. (U.S. Patent No. 5,431,668). For at least the reasons described below, Applicant respectfully traverses these rejections.

Yawata Does Not Disclose a Single Clip Jaw Assembly

Claim 10 relates to a single clip jaw assembly comprising, among other limitations, a pair of jaws and a housing. The jaw assembly is configured to receive "*only a single surgical clip at a time*," and the pair of jaws is adapted to receive a surgical clip "*exteriorly of the jaw assembly*." (Emphasis added). Unlike the jaw assembly recited in Claim 10, Yawata describes a disposable cartridge in which a "*series of clips 108 can be stacked end-to-end in a clip channel 104*." (Yawata, page 9, lines 5-6, Fig. 10, emphasis added). Yawata further describes a mechanism to feed the clips and to assure complete closing of each clip of these series of clips. (Yawata, page 9, line 13-page 11, line 10). Thus, a single surgical clip is not received by the Yawata device from exteriorly of the jaw assembly, as is recited in Claim 10.

Accordingly, for at least the reasons discussed above, Claim 10 is distinguishable over Yawata. Claims 11-18 depend from Claims 10 and recite additional novel and nonobvious limitations thereon. Accordingly, Claims 11-18 are likewise distinguishable over Yawata for at least the reasons discussed above with respect to Claim 10.

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Burbank Does Not Disclose a Single Clip Jaw Assembly

Burbank relates to a "multiple clip applier" (Burbank, col. 5, lines 18-19). The Burbank device includes mechanisms "to perform the clip closing and feeding functions." (Burbank, col. 6, lines 21-24). Burbank discloses multiple clips being stored in a magazine. (See, e.g., Burbank, col. 9, lines 43-46, Figs.1-3). Thus, Burbank fails to disclose a jaw assembly configured to receive "only a single surgical clip at a time," as is recited in Claim 10. Further, Burbank fails to disclose a pair of jaws configured to receive a clip "exteriorly" of the jaw assembly, as is recited in Claim 10.

Accordingly, for at least the reasons discussed above, Claim 10 is distinguishable over Burbank. Claims 11-18 depend from Claim 10 and recite additional novel and nonobvious limitations thereon. Accordingly, Claims 11-18 are distinguishable over Burbank for at least the reasons discussed above with respect to Claim 10.

New Claims 24-28

In the above section entitled Amendments to the Claims, Applicant has directed the addition of Claims 24-28. Claims 24-28 depend from Claim 10 and recite additional novel and nonobvious limitations thereon. Accordingly, Claims 24-28 are distinguishable over the applied art for at least the reasons discussed above with respect to Claim 10. Claims 24-28 are supported in the originally-filed specification, claims, and drawings in this Application. Accordingly, no new matter has been added.

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Conclusion

For at least the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding Office Action are inapplicable to the present claims. Accordingly, issuance of a Notice of Allowability is most earnestly solicited.

Applicant respectfully traverses each of the Examiner's rejections and each of the Examiner's assertions regarding what the prior art shows or teaches. Although amendments have been made, no acquiescence or estoppel is or should be implied thereby. Any arguments in support of patentability and based on a portion of a claim should not be taken as founding patentability solely on the portion in question; rather, it is the combination of features or acts recited in a claim which distinguishes it over the prior art.

The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicant's attorney, John F. Heal, at (949) 713-8283 to resolve such issues promptly.

Sincerely

APPLIED MEDICAL RESOURCES

BY



John F. Heal
Reg. No. 53,008
Tel: (949) 713-8283